

REMARKS**Claim Rejections under 35 USC §102**

Claims 33-50 were rejected by the Examiner under 35 USC §102(e) as being clearly anticipated by either Koblish (2001/0020174), referencing Figures 17-22, paragraphs [0065] and [0093]-[0103]. However, the portions relied upon in the Koblish publication are not found in the earlier filed application (Serial No. 09/447,186, filed on November 22, 1999). As a result, the effective filing date for the portion relied upon is the actual filing date of the Koblish publication, namely April 10, 2001, less than one month prior to the filing date of the present application. Applicants have filed concurrently herewith a Declaration under 37 C.F.R. §1.131 swearing behind the filing date of the Koblish publication, thus removing this reference as prior art against the present invention.

Claim Rejections under 35 USC §103

Claims 33-36 and 38-50 were rejected by the Examiner under 35 USC §103(a) as being unpatentable over Stewart et al. (U.S. Pat. No. 6,325,797) in view of Jaraczewski et al (WO 95/13111). The Examiner referenced column 6, lines 39-55 and Figures 1-7 of Stewart et al., particularly Figure 6 and Figures 3-7 of Jaraczewski. The Examiner contends that the use of the structure of Jaraczewski in the Stewart et al. device to effect the helical shape and deployment would have been obvious. The Examiner contends that such use relates to a mere design equivalent to accomplish a similar result.

Applicants believe that the Examiner's basis for concluding obviousness is not proper under the statute or the case law interpreting the statute. Specifically, the Examiner must show some reason why those skilled in the art would combining the teaching of one reference with the teaching of another reference. A design equivalent is not a suggestion. If the Examiner has found a suggestion in the references to combine the teaching, then applicants respectfully request that the Examiner point out the suggestion in the references. If there is no required suggestion found in the cited references, applicants respectfully request that the rejection be withdrawn.

Notwithstanding the improper combination of references for the rejection under 35 U.S.C. §103, applicants submit that even if the references were properly combined (applicants submit they are not), the references would fail to teach or suggest the invention of claim 33 as amended. Specifically, there is no teaching or suggestion in these references of a core member controlling both the helical shape of the proximal portion of the distal shaft section of the device and the straight shape of the distal portion of the distal shaft section of the device.

Claims 33-43 and 47-50 were rejected by the Examiner under 35 USC §103(a) as being unpatentable over Jenkins et al. (2002/0004631) in view of Jaraczewski et al (WO 95/13111). The Examiner relies upon the teachings of Jenkins et al. for the use of NITINOL to form the coil. However, the NITINOL utilized by Jenkins is a shape memory alloy which must be heated above body temperature in order to form the coiled portion of the device, i.e. it is not

superelastic. The pending claims call for superelastic NITINOL, not a shape memory alloy which requires heating above body temperature to form the coiled shape. Moreover, there is no teaching as to how the straight portion of the core member is either formed or maintained in a straight condition. The Examiner has failed to point out how either of the references would suggest the combination as proposed by the Examiner. Even if the combination was suggestion, the combined teachings of these references fail to teach the claimed elements of the invention.

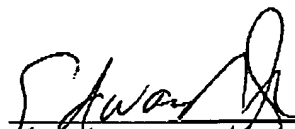
Claim 37 is rejected by the Examiner under 35 U.S. C. §103(a) as being unpatentable over Stewart et al. (U.S. Pat. No. 6,325,797) in view of Jaraczewski et al (WO 95/13111) as applied supra, and further in view of Jenkins et al. (2002/0004631). However, neither Stewart et al. nor Jaraczewski et al. meet or suggest the requirements of the claim from which claim 37 depends. Therefore, the addition of the teaching of the Jenkins et al. reference also fails to suggest the invention claimed in claim 37.

Applicants believe that the pending claims define patentable subject matter and request reconsideration and an early allowance.

Respectfully submitted,

DUANE MORRIS LLP
One Market
Spear Tower, Ste. 2000
San Francisco, CA 94105
Direct Dial: (415) 371-2267
Facsimile: (415) 371-2201

By:


Edward J. Lynch
Reg. No. 24,422
Attorney for Applicants